

REMARKS

The Office Action mailed March 24, 2006 has been reviewed and carefully considered. Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 2 and 4 through 25 are pending, with claims 1, 19, and 25 being independent claims. Claims 1, 19, 25 are hereby amended. Claim 3 have been cancelled without admission and without prejudice to Applicant's right to pursue the canceled subject matter in one or more Continuation applications. No new matter has been added.

The Examiner rejects claims 1, 8, 10, 11, 13 through 16, 18, 19, 21, 23, and 25 under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2005/0071255 to Wang, et al. ("Wang"). In the Office Action, the Examiner further rejects claims 2 through 7, 9, 12, 17, 20, 22, and 24 under 35 U.S.C. 103(a) as being obvious over Wang in view of U.S. Patent No. 6,640,218 issued to Golding, et al. ("Golding"). The Applicants respectfully traverse the rejections and assert that the claims pending in the present application are patentable over the reference cited by the Examiner for at least the reasons stated below.

The newly amended independent claim 1 comprises method of scoring data for use in a search engine. According to independent claim 1, the method comprises tracking clicks by users on data returned in a search result in response to a query. The method further comprises determining a user preference for a clicked data in accordance with a physical position of the clicked data in the search result, wherein determining a user preference for a clicked data is performed by determining a ratio of actual clicks to clicks expected for the clicked data and a specific query. Independent claims 19 and 25 are

directed to a system and a computer program product that comprises substantially similar elements to those claimed by independent claim 1.

Wang does not teach, disclose or otherwise suggest that determining a user preference for clicked data is performed by determining a ratio of actual clicks to clicks expected for the clicked data and a specific query. Rather, the system of Wang keeps track of actual user clicks based on the search result set and returns a second search result set in response to the user query and based upon the tracked user clicks. ¶ 0028. For at least the above reasons, Wang does not anticipate independent claim 1 as amended, and reconsideration and allowance of independent claim 1 is respectfully requested. Independent claims 19 and 25 are allowable for substantially similar reasons as those presented in connection with independent claim 1.

Regarding the rejection of the pending claims as obvious as identified above, Applicant asserts that the Examiner is improperly citing Wang as prior art under 35 U.S.C. §103(a). At the time the invention described in the present application was made, Wang was owned by Yahoo!, Inc. Therefore, Applicants assert common ownership in accordance with MPEP 706.02(l)(2), disqualifying Wang as prior art under 35 U.S.C. 103(c). Reconsideration and withdrawal of the rejection of claims 2 through 7, 9, 12, 17, 20, 22, and 24 under 35 U.S.C. §103 is respectfully requested in light of the above remarks.

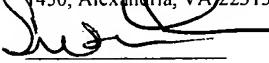
The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over the art of record. Given the Applicant's position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

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For the above reasons, the Applicant submits that the present invention, as claimed and presently amended, is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 1, 2 and 4 through 25 is therefore respectfully solicited. To expedite prosecution, the Examiner is invited to contact the Applicant's representative at the number below.

Dated: July 21, 2006

I hereby certify that this paper and any accompanying papers referenced herein are being deposited this date with the U.S. Postal Service as First Class Mail with sufficient postage addressed to Mail Stop: Amendment: Commissioner for Patents, P.O. Box 450, Alexandria, VA 22313-1450


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July 21, 2006
Date

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